

PATENT  
Attorney Docket No. 331235-00021**REMARKS**

On entry of the instant Amendment, Claims 78 through 80 are pending. Claim 78 has been amended to more particularly point out the Applicant's invention. It is respectfully submitted that an earnest attempt has been made to address all of the issues raised in the instant official action. Accordingly, it is respectfully submitted that the Application is in condition for allowance.

**Priority Date**

Paragraph 3 of the Detailed Action states that the Applicant's request for benefit of filing date before April 18, 2000 is denied. The Examiner is respectfully request to reconsider his position in this regard. More particularly, the instant Applicant was filed as a continuation of Application No. 09/551,766, filed April 18, 2000 ("the '766 application"). The '766 application is a continuation of Application No. 09/162,184, which issued on August 15, 2000 (the '184 application. Since the '766 application was filed on April 18, 2000 and the '184 application did not issue until August 15, 2000, it is clear that the '766 application was filed during the pendency of the '184 application. As such, it should be clear that the instant application is at least entitled to the priority of the '184 application.

The '184 application, in turn, is a continuation of Application No. 08/845,012 ("the '012 application"). Paragraph 3 of the Detailed Action acknowledges that copendency exists between each of the following application nos. : the '012 application and application nos. 08/235,290; 07/903,342; and 07/683,243. The Specification has been amended to reflect the correct chain of continuity applications. Accordingly, it is respectfully submitted that the instant application is entitled to claim priority date back to April 10, 1991 pursuant to 35 U.S.C. § 120. Be that as it

PATENT  
Attorney Docket No. 331235-00021

may, the subject matter of the current claims is entitled of a priority date at least as early as Application No. 08/235,290, filed on April 29, 1994. Accordingly, it is respectfully submitted that many of the patents cited against the instant Application do not qualify as prior art within the meaning of 35 U.S.C. § 102. For the convenience of the examiner, each of the fourteen patents cited against the instant Application are listed below, with the earliest effective date as a prior art reference pursuant to 35 U.S.C. 102(e).

Item No.	Inventor	Patent No.	Earliest Effective Date
1	Gunn	4,024,380	7/14/1975
2	Wright, et al.	4,802,218	11/26/1986
3	Pusic	5,065,000	8/1/1988
4	Ramsden	5,340,948	1/24/1992
5	Ramsden	5,369,221	12/22/1993
6	Ramsden	5,481,464	2/18/1994
7	Ramsden	5,656,799	4/29/1994
8	Kara, et al.	5,778,076	8/16/1995
9	Kara, et al.	5,801,304	10/10/1996
10	Whimey, et al.	5,796,834	3/6/1997
11	Kara	5,812,991	10/2/1996
12	Ramsden, et al.	5,831,220	4/22/1997
13	Kara	6,233,568	6/29/1998
14	Ramsden, et al.	6,105,014	9/29/1998

As mentioned above, the subject matter of the instant Claims is entitled to priority at least as early as April 29, 1994. Accordingly, it is respectfully submitted that the patents identified above as Items 7 through 14 do not qualify as prior art within the meaning of 35 U.S.C. § 102, since the earliest effective date of each of these patents is either on or after April 29, 1994.

Accordingly, the examiners respectfully request to withdraw those rejections based on those patents identified above with Items 7 through 14.

### **Objections to the Specifications**

A number of objections to the specifications have been noted in Paragraphs 5 through 7 of the Application. In addition, Paragraph 6.1 of the detailed action relates to objections to the drawings. It is respectfully submitted that each and every one of the objections to the specifications have been addressed and incorporated into an amendment to the specification. It is respectfully submitted that no new matter has been added. It is further submitted that the amendments to the specification overcome any requirement for any drawing corrections. Accordingly, it is respectfully submitted that all of the objections to the specification and drawing have been overcome.

### **Claims Rejections – 35 U.S.C. 112**

Claims 77 through 80 have been rejected under 35 U.S.C. 112, second paragraph, for being indefinite for failing to particularly point out and distinctly claim the subject matter which the Applicant regards as the invention. The specific rejections are set forth in Paragraphs 9.1 and 9.2 of the Detailed Action. It is respectfully submitted that the instant Amendment to the Specification should overcome each and every one of the rejections set forth in Paragraphs 9.1 and 9.2. For all of the above reasons, the Examiner is respectfully request to reconsider and withdraw this rejection.

**Claims Rejections – Double Patenting**

Claims 77 through 80 have been provisionally rejected under the judicially created doctrine of global patenting over Claims 76 through 77 of co-pending Application No. 09/551,766. Claims 77 through 80 have also been rejected under the judicially created doctrine of double patenting over either Claims 1 through 59 of U.S. Patent No. 5,656,799 or Claims 1 through 4 of U.S. Patent No. 5,831,220 or Claim 1 of U.S. Patent No. 6,105,014. In order to overcome these rejection, terminal disclaimers disclaiming the terminal portions of Application No. 09/551,766 as well as U.S. Patent Nos. 5,656,799; 5,831,220; and 6,105,014 are attached. Thus, it is respectfully submitted that this objection should be overcome.

**Claims Rejections – 35 U.S.C. 101**

Claims 77 through 80 have been rejected under 35 U.S.C. 101 for allegedly failing to provide interconnection between the various elements recited in the Claims. It is respectfully submitted that the instant Amendment to Claim 77 should overcome this rejection. Each of the claim elements is clearly interrelated to the other elements. For all of the above reasons, the examiner is respectfully request to reconsider and withdraw this rejection.

**Claims Rejections – 35 U.S.C. 102(b)**

Claim 77 has been rejected under 35 U.S.C. 102(b) as being anticipated by Gunn U.S. Patent No. 4,024,380 or Wright, et al. U.S. Patent No. 4,802,218 or Pusic U.S. Patent No. 5,065,000 or Ramsden; U.S. Patent No. 5,340,948 or Ramsden U.S. Patent No. 5,369,221 or Ramsden U.S. Patent No. 5,481,464 or Ramsden, U.S. Patent No. 5,656,799 or Kara, et al. U.S. Patent No. 5,788,076 or Kara et al U.S. Patent No. 5,801,364 or Whitney, et al. U.S. Patent No.

PATENT  
Attorney Docket No. 331235-00021

5,796,834 or Kara U.S. Patent No. 5,812,991 or Ramsden, et al. U.S. Patent No. 5,831,220. Claim 77 has also been rejected under 35 U.S.C. 102(e) as being anticipated by Kara U.S. No. 6,233,568 or Ramsden, et al. U.S. Patent No. 6,105,014.

As discussed above, the subject matter of the instant Claims is at least entitled to priority of Application No. 08/235,290, filed on April 29, 1994, which matured into U.S. Patent No. 5,656,799. Accordingly, it is respectfully submitted that Ramsden U.S. Patent No. 5,656,799; Ramsden et al US Patent Nos. 5,831,220; and 6,105,014, as well as Kara, et al. U.S. Patent Nos. 5,778,076; 5,801,364; Kara US Patent Nos. 5,812,991 and 6,233,568, as well as Whitney, et al. U.S. Patent No. 5,796,834, are not prior art within the meaning of 35 U.S.C. §102. Therefore, the Examiner is respectfully request to reconsider and withdraw the rejections based on the aforementioned patents.

With respect to the balance of the patents, in order for there to be anticipation, each and every one of the elements of the Claims must be found in a single reference. It is respectfully submitted that the Claims, as amended, recite subject matter clearly not disclosed *or suggested* in the references. For example, the claims now recite a processor for receiving customer information regarding the desired delivery option selectable from at least two different delivery options. None of the patents identified above as Item Nos. 1 through 6 disclose *or suggest* such an option. Accordingly, there can be no anticipation.

Claim 78 has been rejected under 35 U.S.C. 102(b) as being anticipated by Wright, et al. U.S. Patent No. 4,802,218 or Pusic U.S. Patent No. 5,065,000 or Ramsden U.S. Patent No. 5,656,799 or Kara, et al. U.S. Patent Nos. 5,778,076 or 5,801,364 or Whitney, et al. U.S. Patent No. 5,796,834 or Kara U.S. Patent No. 5,812,991 or Ramsden, et al. U.S. Patent No. 5,831,220.

PATENT  
Attorney Docket No. 331235-00021

As discussed, other than the Wright, et al. or Pusic patents, the rest of the patents cited do not qualify as prior art within the meaning of 35 U.S.C. §102. With respect to the Wright, et al. and Pusic patents, it is respectfully submitted that Claim 78 is dependent on Claim 77 and, therefore recites in combination a system which provides two selectable mail delivery options. As discussed above, neither the Wright, et al. patent nor the Pusic patent discloses *or suggests* such a system. For all of the above reasons, the examiners respectfully request to reconsider and withdraw this rejection.

Claim 78 has also been rejected under 35 U.S.C. 102(e) as being anticipated by Kara U.S. Patent No. 6,233,568 or Ramsden, Patent No. 6,105,014. As mentioned above, neither the Kara '568 nor Ramsden, et al. '014 qualify as prior art within the meaning of 35 U.S.C. § 102. Accordingly, the Examiner is respectfully request to reconsider and withdraw this rejection.

Claim 79 has been rejected under 35 U.S.C. 102(b) as being anticipated by Ramsden U.S. Patent Nos. 5,340,948; 5,369,221; 5,481,464; and 5,656,799 or Ramsden, et al. U.S. Patent No. 5,831,220. As mentioned above, the Ramsden '799 and Ramsden, et al. '220 do not qualify as prior art. With respect to the Ramsden '948 and '221 and '464 patents, these patents do not disclose *or suggest* all of the elements of the claims as discussed above. In particular, Claim 79 recites in combination a system which allows a selection between two delivery options. As discussed above, none of those patents disclose *or suggest* such a system. Accordingly, there can be no anticipation.

Claim 79 has been rejected under 35 U.S.C. 102(e) as being anticipated by Ramsden, et al. U.S. Patent No. 6,105,014. As mentioned above, the Ramsden, et al. '014 patent does not

PATENT  
Attorney Docket No. 331235-00021

qualify as prior art pursuant to 35 U.S.C. 102. Accordingly, the Examiner is respectfully request to reconsider and withdraw this rejection.

Claim 80 has been rejected under 35 U.S.C. 102(b) as being anticipated by either Pusic U.S. Patent No. 5,065,000 or Ramsden U.S. Patent Nos. 5,340,948; 5,369,221; 5,481,464; or 5,656,799 or by Ramsden, et al. U.S. Patent No. 5,831,220. As mentioned above, the Ramsden '799 patent, as well as the Ramsden, et al. '220 patent, do not qualify as prior art within the meaning of 35 U.S.C. §102. Regarding the other references cited against claim 80, it is respectfully submitted that Claim 80 recites elements clearly not disclosed *or suggested* in the Pusic '000 patent or in the Ramsden '948; '221; or '464 patents. In particular, Claim 80 recites in combination a system which allows a customer to select between various delivery options. This feature is not disclosed or suggested by those references. Accordingly, the Examiner is respectfully request to reconsider and withdraw this rejection.

PATENT


Attorney Docket No. 331235-00021

Claim 80 has been rejected under 35 U.S.C. 102(e) as being anticipated by Ramsden, et al. U.S. Patent No. 6,105,014. As mentioned above, the Ramsden, et al. '014 patent does not qualify as prior art within the meaning of 35 U.S.C. § 102. Accordingly, the Examiner is respectfully request to reconsider and withdraw this rejection.

Respectfully submitted,

KATTEN MUCHIN ZAVIS ROSENMAN

By:

  
John S. Paniaguas

Registration No. 31,051

Attorney for Applicant(s)

Katten Muchin Zavis Rosenman  
525 W. Monroe Street  
Chicago, Illinois 60661-3693  
(312) 902-5200  
(312) 902-1061 - facsimile  
Customer No. 27160